



**UNITED STATES DEPARTMENT OF COMMERCE**  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/242,257	09/07/99	GROLLET	J RICHE4827.01

VENABLE  
POST OFFICE BOX 34385  
WASHINGTON DC 20043-9998

IM22/1004

EXAMINER

DUBOIS, P

ART UNIT	PAPER NUMBER
1761	9

DATE MAILED: 10/04/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/242,257

Applicant(s)

GROLLET, JEAN

Examiner

DuBois

Art Unit

1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 September 1999.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some \* c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) \_\_\_\_\_.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Objections***

Claims 1-10 are objected to because of the following informalities: The terms enclosed within parentheses and quotes should be removed. In claims 5 and 6, the term "can be" is recited. Although it is believed that the applicant intended to include the subject matter following the term "can be" as a limitation, the term suggests that the limitation is optional. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the phrase "or the like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Regarding claims 2, 22, 23 and 25-26 the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

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A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 22 and 23 recite the broad recitation "spraying means", and the claims also recite "preferably positionable" which is the narrower statement of the range/limitation. Claims 15 and 24 recite the broad recitation "food additives", and the claims also recite "preferably natural and soluble" which is the narrower statement of the range/limitation. The claims will be construed as incorporating the broadest limitation.

The term "natural consistency" in claim 7 is a relative term which renders the claim indefinite. The term "natural consistency" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

The term "several seconds to several dozen seconds" in claims 8 and 16 is a relative term that renders the claim indefinite. The term "several seconds to several dozen seconds" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

The term "sufficient contact time" in claim 16 is a relative term which renders the claim indefinite. The term "sufficient contact time" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The scope of "sufficient contact time" is unclear. Furthermore, it is unclear whether the term "sufficient contact time" is a broader limitation to a narrow limitation of "several seconds to several dozen seconds".

Claim 8 recites the limitation "the wrapping of the product" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: a separate process to compare the limitations of claim 22. The claim recites the limitation of "a separate process". However, the claim does not identify another to distinguish the limitations of the claim.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 25 and 26 provide for the use of a composition and device, respectively, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 25 and 26 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 9-11, 15, 21-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Duffy et al (U.S. Patent 5,202,137).

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Duffy et al (Duffy) teaches a method for coating a food product. The food products that can be coated include peanuts, chocolate pieces already coated with a white chocolate compound, confectioneries such as those having a cream fondant and coconut center coated with a chocolate compound and bakery products (U.S. Patent 5,202,1~~4~~<sup>3</sup>7, col. 2, lines 30-35). The coating comprises a shellac solution in a food grade alcohol (col. 55-60). The solution to form the coating can be sprayed onto the food product (col. 3, lines 1-5). In addition to shellac and alcohol, food additives such as monoglycerides can be incorporated into the product (col. 2, lines 55-60). The term "possibly" in claim 2 is interpreted as optionally.

Applicant's attention is directed to *In re Thorpe*, 227 U.S.P.Q. 964 (CAFC 1985). It is stated therein:

Determination of patentability in "product-by-process" claims is based on the product itself, even though such claims are limited and defined by the process, and thus the product in such claims is unpatentable if it is the same as, or obvious from, the product of the prior art, even if the prior product was made by different process.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-8 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duffy.

Duffy is being applied for the reasons noted above. Although not noted above, Duffy teaches that the spray coating parameters are inlet temperatures of 40°C and outlet temperatures of 25°C. In example 2, Duffy teaches that the chocolate pieces can be warmed at a temperature no higher than the melting temperature to smooth the surface of the piece. After heating, the pieces can be cooled before coating. Duffy teaches that the temperatures of the process will vary with different types of chocolate. (col. 3, lines 15-25). Thus, it would have been obvious to one of ordinary skill in the art to optimize the temperature of the process depending on the type of chocolate used. Duffy teaches that the food product and coating can be placed in a cooling cabinet too fully dry before further processing (col. 4, lines 5-10). It would have been expected by one of ordinary skill in the art that a chocolate covering would contain the necessary and known properties of dark chocolate.

Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duffy as applied to claims 1, 2, 9-11, 15, 21-26 above, and further in view of Merory (Food Flavorings)

Duffy is being applied for the reasons noted above. However, Duffy is silent as to the addition of benzoin (benjamin gum) and Peru Balsam. Merory teaches that it is desirable to add Peru Balsam and benzoin to food products as they have a pleasant odor and flavor (Food Flavorings, pg. 88-87). Thus, it would have been obvious to one



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of ordinary skill in the art to optimize the amount of Peru Balsam and benzoin as they affect the flavor of the product.

In addition, it would have been obvious to one of ordinary skill in the art to provide the references noted above with Peru Balsam and benzoin as they provide a pleasant flavor and odor to a food product, as taught Merory.

Claims 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duffy as applied to claims 1, 2, 9-11, 15, 21-26 above, and further in view of Beckett (Industrial Chocolate Manufacture and Use).

Duffy is being applied for the reasons noted above. However, Duffy is silent as to a recovery means for the excess coating product and as to the type of conveyor used in the process. Beckett teaches that a reservoir tank can be used to return excess coating material back to a tank. The excess coating material can then be recycled and applied to more products passing along the conveyor (Industrial Chocolate Manufacture and Use, pg. 212). Furthermore, Beckett teaches a wired conveyor system which increases the amount of coating applied in the coating process (Industrial Chocolate Manufacture and Use, pg. 224).

Thus, it would have been obvious to one of ordinary skill in the art to provide Duffy with a recovery means because a recovery means lowers cost by preventing waste, as taught by Beckett.

### ***Conclusion***

1. No claim is allowed.

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2. Any inquiring concerning this communication or earlier communications from the examiner should be directed to Philip DuBois whose telephone number is (703) 305-0508. The examiner can normally be reached on Monday through Friday from 8:00 to 5:30. The examiner is not in the office the second and fourth Fridays of each month.

3. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gabrielle Brouillette, can be reached at (703)-308-0756. The fax number for the group is (703)-305-3602.

4. Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 308-0661.

Philip DuBois

9/7/00

9/29/00

*G. Brouillette*  
GABRIELLE BROUILLETTE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700

10/2/00